

**REMARKS**

**INTRODUCTION:**

No claims have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-7 are pending and under consideration. Reconsideration is respectfully requested.

**REJECTION UNDER 35 U.S.C. §102:**

In the Office Action, at page 2, item 3, claims 1, 2, and 4 were rejected under 35 U.S.C. §102 as being anticipated by Murai (U.S. Patent 6,208,639 B1). The reasons for the rejection are set forth in the Office Action and therefore not repeated. This rejection is traversed, and reconsideration is requested. Claims 1 and 4 are independent, and claim 2 is dependent.

The Examiner takes the position that Murai discloses a telecommunication apparatus 10 for initiating and receiving voice and data. This is incorrect. Murai discloses a Private Branch Exchange (PBX) 10 in the form of a time multiplexed telecommunication router for data packets (see the Abstract, and col. 3, lines 60-67 and col. 4, lines 7-8). This PBX (Item 10 in Fig.1) cannot initiate, nor receive any voice or data calls. It can only route calls between initiating and receiving telecommunication apparatuses according to instructions in the circulating data packets.

Murai clearly states that all calls are initiated or received by computers (50 in Fig. 3) or old-fashioned telephone apparatuses (14a in Fig. 2) connected to the PBX 10 locally or remotely (see col. 7, lines 41-47 and col. 9, lines 54-62). No calls are initiated or received by the PBX 10.

Further, item 28 in Fig. 1 of the Murai reference is a microprocessor (CPU), not a gateway means. Switches in the PBX 10 under the control of the CPU 28 can, however, act as gateways to a PSTN for packet based signals coming in from a local or remote computer network. But the gateway means included in Murai's PBX 10 is not included in an end user apparatus. The gateway means included in Murai's PBX 10 works the same way as gateways

owned and operated by a telecom company, which is known in the art and different from the present invention of distributed gateways.

Gateways are not new in the art, and the present invention is not claiming gateways *per se*. Rather, what is claimed by the present invention is *a telecommunication apparatus for initiating and receiving voice and data calls which includes a local gateway means between a circuit switched telecommunication network (PSTN) and a packet based telecommunication network in an end-user apparatus for telecommunication*. Thus, both independent claims 1 and 4 include such a "gateway means for establishing a path between said first port and said second port inside said apparatus in response to a request imbedded in an incoming call" via the second port, which connects to the packet based telecommunication network, in this end-user telecommunication apparatus.

There is nothing in the Murai reference that anticipates the present invention as claimed, nor could the Murai reference suggest to anyone skilled in the art to have gateway means distributed in individual end-user apparatuses for initiating and receiving voice and data calls. Therefore, Applicant respectfully submits that the Murai reference does not anticipate independent claims 1 or 4 of the present invention. As claim 2 depends directly from claim 1 and incorporates additional features, Applicant respectfully submits the Murai reference fails to anticipate the invention of claim 2 for at least the same reasons as claim 1. Thus, Applicant respectfully submits that claims 1, 2, and 4 are in condition for allowance.

#### REJECTION UNDER 35 U.S.C. §103:

In the Office Action, at page 4, item 5, dependent claim 3 was rejected under 35 U.S.C. §103 over Murai in view of U.S. Patent No. 6,243,377 to Phillips et al. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Claim 3 depends indirectly from claim 1 and directly from claim 2, and incorporates additional features. As discussed above, Applicant respectfully asserts that the Murai reference fails to disclose all of the limitations of claims 1 or 2. Thus, the Murai reference, taken in combination with the Phillips reference, fails to teach or suggest the present claimed invention. Accordingly, Applicant respectfully submits that claim 3 is in condition for allowance.

In the Office Action, at pages 4-5, item 6, dependent claims 5-7 were rejected under 35 U.S.C. §103 over Murai in view of U.S. Patent No. 6,259,691 to Naudus et al. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Claims 5 through 7 depend, either directly or indirectly, from claim 4 and include additional features. As discussed above, the Murai reference fails to teach or suggest all of the features of claim 4. Thus, the Murai reference, taken in combination with the Naudus reference, fails to teach or suggest the present claimed invention. Accordingly, Applicant respectfully submits that claims 5 through 7 are in condition for allowance.

Applicant acknowledges that, in "hindsight", it may seem obvious to include gateway means in individual end-user telecommunication apparatuses. Hindsight, however, is not a valid objection to the patentability of a new combination of existing elements (see our previous Response, filed January 2, 2004, page 7, last paragraph). It is well-established that references must be viewed without the benefit of hindsight vision provided by the present invention (see, e.g., *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)). Further, the references, considered as a whole, must suggest the desirability of making the combination (see, e.g., *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984)). Additionally, the Examiner must consider the claimed invention as a whole because, although the difference between the claimed invention and the prior art might seem slight, it could also be of great importance to the advancement of the art (see, e.g., *Jones v. Hardy*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1024 (Fed. Cir. 1984)).

In support of Applicant's position, Applicant respectfully submits that shifting the location of gateways from a few concentrated locations operated by telecommunication companies to a large number of local individual gateways represents several advantages over the state of the art in 1999. Shifting the gateways to individual users allows unlimited, immediate expansion and eliminates the bottlenecks experienced when the user base expands more rapidly than the telecommunication companies increase network capacity. Additionally, the reliability and stability of the telecommunications system are improved because the gateways are distributed. If one gateway is damaged, the effect on the total system will be negligible because the load on the gateways is more widely distributed. Finally, the Gateway Telephone 200 presents an

economic benefit in that the inclusion of a gateway minimally impacts the cost of the device. In contrast, the network gateways used by telecommunications companies require a physical location, as well as more expensive hardware. Thus, by incorporating gateway means into individual end-user telecommunication apparatuses, the present invention creates both economic and practical advantages over the system presently utilized for IP telephony.

CONCLUSION:

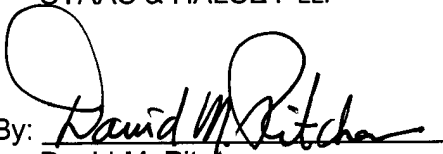
In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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